

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Janakiraman et al.** § Appeal No.: **2008-0998**
§
Serial No.: **09/842,835** §
§ Group Art Unit: **2179**
Filed: **April 26, 2001** §
§ Examiner: **Theriault, Steven B.**
For: **Apparatus for Outputting Textual
Renditions of Graphical Data and
Method Therefor** § Confirmation No.: **8492**

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

REQUEST FOR REHEARING (pursuant to 37 CFR § 41.52)

This Request for Rehearing is submitted in response to the Decision on Appeal mailed on February 6, 2009.

No fees are believed to be required to file a Request for Rehearing. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

RESPONSE TO DECISION ON APPEAL

ERROR IN DECISION:

Appellants urge that the Decision on Appeal issued by the Board on February 4, 2009 is erroneous for at least two (2) fundamental reasons:

- (1) The rejection of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 was stated to be 'affirmed' by the Board with respect to a 35 U.S.C. § 103 rejection, and yet these Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 were not rejected by the Examiner under 35 U.S.C. § 103 (and therefore the affirmation of a non-existent, phantom rejection of these claims under 35 U.S.C. § 103 is error); and
- (2) With respect to independent Claims 1, 15 and 22: (i) the KSR-obviousness requirements have not been met, and (ii) no *prima facie* obviousness has been established with respect to such claims, and therefore these Claims 1, 15, and 22 have been erroneously rejected and affirmed under 35 U.S.C. § 103.¹

BACKGROUND:

- Claims 1-3, 6-10, 13-17, 20-22, 24-26 and 28-33 were rejected by the Examiner under 35 U.S.C. § 102
- Claims 4-5, 11-12, 18-19, 23 and 27 were rejected by the Examiner under 35 U.S.C. § 103

ANALYSIS:

The Board *reversed* the Examiner on the 35 U.S.C. § 102 rejection of Claims 1-3, 6-10, 13-17, 20-

¹ This same issue, and resulting error, also applies to the phantom 35 USC 103 rejection, and resulting affirmation, of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33, per identified error (1) described herein.

22, 24-26 and 28-33, and *affirmed* the Examiner on the 35 U.S.C. § 103 rejection of Claims 4, 5, 11, 12, 18, 19, 23 and 27. The Board also noted, in the 35 U.S.C. § 103 rejection, that the Examiner *should have* also rejected independent Claims 1, 15 and 22, and so the Board treats these Claims 1, 15 and 22 as having been *implicitly* rejected by the Examiner under 35 U.S.C. § 103 (see page 3 of the Board Decision).

The problem is that Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 do not fall under such ‘implicit rejection’ conclusion, and these Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 were not rejected by the Examiner under 35 U.S.C. § 103 (they are separate claims with no linkage to rejected dependent Claims 4-5, 11-12, 18-19, 23 and 27 – and in fact several of these claims are *independent claims*). Importantly, the only rejection of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 was under 35 U.S.C. § 102, and the Board expressly reversed such 35 U.S.C. § 102 rejection. Appellants also did not group these Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 with Claim 1 in any type of 35 U.S.C. § 103 rejection or associated response thereto.

However, the Board reaches the erroneous conclusion on page 19 of the Decision on Appeal that the Examiner’s rejection of all pending claims under 35 U.S.C. § 103 is affirmed (“We affirm the Examiner’s stated decision rejecting claims 4, 5, 11, 12, 18, 19, 23, and 27 and the Examiner’s **implied** decision rejecting **claims 1-3, 6-10, 13-17, 20-22, 24-26, and 28-33 under 35 U.S.C. § 103**” (emphasis added by Appellants) – and yet Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 were never rejected, *either explicitly or implicitly*, by the Examiner under 35 U.S.C. § 103 so the Board cannot properly affirm such phantom rejection of these Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 under 35 U.S.C. § 103. It is urged that this is clear error in the Board’s Decision on Appeal.

Additionally, when the Board reached the conclusion that “the Examiner is considered to have rejected all claims from which claims 4, 5, 11, 12, 18, 19 or 23 depend” (where independent Claims 1, 15 and 22 were deemed to have been implicitly rejected under 35 U.S.C. § 103), such conclusion in effect short-circuited any finding or establishment of *prima facie* obviousness by the Examiner for such claims. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational**

underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).” Appellants urge that the Examiner record provides no articulated reasoning with any rationale underpinnings to support a legal conclusion of obviousness with respect to Claims 1, 15 and 22, and thus the KSR-obviousness requirements have not been met in rejecting – and affirming such rejection for - these Claims 1, 15 and 22, which is clear legal error.²

In rejecting claims under 35 U.S.C. Section 103, the **examiner** bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis added by Appellants). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* **If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned.** *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added by Appellants). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Appellants urge that since *no* Examiner reasoning has been provided as to why the missing claims features recited in the Claims 1, 15 and 22 would have been obvious, a proper *prima facie* showing of obviousness has not been established, and therefore the rejection is improper and should be overturned, *In re Fine*, *supra*.³

In addition, and as a direct result of the Examiner not having established *prima facie* obviousness with respect to Claims 1, 15 and 22, Appellants have had no opportunity to rebut any obviousness assertion with respect to such claims – which is a violation of due process and fundamental fairness.⁴

² This same issue, and resulting error, also applies to the phantom 35 USC 103 rejection, and resulting affirmance, of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33, per identified error (1) described herein.

³ This same issue, and resulting error, also applies to the phantom 35 USC 103 rejection, and resulting affirmance, of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33, per identified error (1) described herein.

CONCLUSION

Appellants therefore urge that the Board reconsider, and withdraw, their affirmance of a phantom rejection of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 under 35 U.S.C. § 103, as the Examiner never rejected Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33 under 35 U.S.C. § 103, either explicitly or implicitly.

Appellants further urge that the affirmance of an implicit rejection of Claims 1, 15 and 22 under 35 U.S.C. § 103 be withdrawn, as such implicit rejection (i) fails to comply with US Supreme Court precedent regarding obviousness, (ii) fails to comply with the *prima facie* obviousness requirements, and (iii) violates due process and fundamental fairness.⁵

/Wayne P. Bailey/
Wayne P. Bailey
Reg. No. 34,289
YEE & ASSOCIATES, P.C.
PO Box 802333
Dallas, TX 75380
(972) 385-8777

⁴ This same issue, and resulting error, also applies to the phantom 35 USC 103 rejection, and resulting affirmance, of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33, per identified error (1) described herein.

⁵ This same issue, and resulting error, also applies to the phantom 35 USC 103 rejection, and resulting affirmance, of Claims 2, 3, 6-10, 13-14, 16, 17, 20, 21, 24-26 and 28-33, per identified error (1) described herein.